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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
ALLAN S. ALGAZI

Serial No.: 09/759,566

Filed: January 11, 2001

For: IMPROVED SYSTEM AND METHODS
FOR TRANSPORTATION AND
DELIVERY USING BAR CODES

Examiner: J. WEBB

Group Art Unit: 3629

Att'y Docket: 6000.001200

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
37 C.F.R. 1.8

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Sir:

Applicant hereby submits an original and two copies of this Appeal Brief to the Board of Patent Appeals and Interferences in response to the final Office Action dated October 29, 2004. A Notice of Appeal for the above captioned patent application was filed January 5, 2005, so this Appeal Brief is believed to be timely filed.

Enclosed is a check for \$500.00. If the check is inadvertently omitted, the Commissioner is authorized to deduct the fee for filing this Appeal Brief (\$500) from Williams, Morgan & Amerson's P.C. Deposit Account 50-0786/6000.001200.

03/09/2005 HALI11 00000022 09759566

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I. REAL PARTY IN INTEREST

The present application is owned by Symbol Technologies, Inc. The assignment of the present application to Symbol Technologies, Inc., is recorded at Reel 11471, Frame 0097.

II. RELATED APPEALS AND INTERFERENCES

Applicant is not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF THE CLAIMS

Claims 1-41 are pending in the application. The claims as currently pending are attached as Appendix A. Claims 4-9, 16-21, and 24-41 have been withdrawn from consideration. Claims 1-2, 10-11, 13-14, and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Recktenwald, *et al.* (U.S. Patent No. 6,439,345) in view of Smithies, *et al.* (U.S. Patent No. 5,647,017). Claims 3 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Smithies and further in view of Stephens, *et al.* (U.S. Patent No. 6,323,782). Claims 12 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Smithies and further in view of Keagy, *et al.* (U.S. Patent No. 6,069,969).

IV. STATUS OF AMENDMENTS

There were no amendments after the final rejections.

V. SUMMARY OF THE INVENTION

The Internet has produced a proliferation of e-commerce transactions, at least in part because e-commerce transactions offer convenience and speed to customers seeking to purchase goods online. Most e-commerce transactions end with the physical delivery of goods to a customer. However, the delivery stage is particularly prone to error and/or sabotage and goods purchased online may be inadvertently or maliciously routed to the wrong destination.

The present invention provides an improved method for the handling and delivery of packages and other e-commerce transactions using the security features available in two-dimensional bar codes. Two-dimensional bar codes have been developed to encode more information in a smaller space. Where traditional one-dimensional bar codes act as a pointer to reference information stored in a database, two-dimensional bar codes can function as the database itself and therefore insure complete portability for two-dimensional label items. For example, Portable Data File 417 (PDF417) is a two-dimensional stacked bar code symbology capable of encoding over a kilobyte of data per label. See Patent Application, page 4, ll. 9-17. Examples of two-dimensional barcodes are shown in Figures 2, 4, and 4A of the Patent Application.

Two-dimensional bar codes may be used as a key to access information. For example, a consumer desiring information or goods from a provider may present a barcode previously obtained from the provider that encodes information about the consumer that only the consumer can verify. If the provider matches the information from the barcode with the information provided by the consumer, the provider can allow access to the desired information or goods without fear that a fraud or mistake has taken place. The encoded information may include

biometric data such as facial appearance, signatures, thumb prints, handprints, voice prints, retinal scans, and the like.

In particular, claim 1 sets forth a method of obtaining a package that includes notifying a user electronically that a package has arrived at a predetermined location and printing a paper receipt including a two-dimensional bar code encoding the user's previously provided biometric information. The two-dimensional bar code is scanned and decoded at the predetermined location to obtain the user's previously provided biometric information and conveying the user's current biometric information to a retrieval device. If the user's current biometric information is equivalent to the user's current biometric information, the package is provided to the user by the retrieval device.

Claim 13 sets forth an apparatus for delivering goods that includes a notifier for notifying a user electronically that a package has arrived at a predetermined location, a scanner for scanning a two-dimensional bar code provided by a user at the predetermined location, and a decoder for decoding the user's previously provided biometric information from the two-dimensional bar code. The apparatus also includes a collector for collecting the user's current biometric information, a comparator for comparing the user's current biometric information and the user's previously provided biometric information, and a provider for providing the package to the user if the user's current biometric information matches the user's previously provided biometric information.

VI. ISSUE ON APPEAL

Appellant respectfully requests that the Board review and overturn the three rejections present in this case. The following issues are presented on appeal in this case:

(A) Whether claims 1-2, 10-11, 13-14, and 22 are obvious over Recktenwald in view of Smithies;

(B) Whether claims 3 and 15 are unpatentable over Recktenwald and Smithies and further in view of Stephens; and

(C) Whether claims 12 and 23 are unpatentable over Recktenwald and Smithies and further in view of Keagy.

VII. GROUPING OF THE CLAIMS

For the issues presented above, claims 1-3, 10-11, 13-15, and 22 may be considered to stand or fall together. Appellants respectfully submit that claims 12 and 23 include additional patentable features and therefore may be considered to stand and fall together. In particular, claims 12 and 23 set forth, among other things, a two-dimensional bar code formed according to PDF417 symbology.

VIII. ARGUMENT

A. Legal Standards

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

B. Claims 1-2, 10-11, 13-14, and 22 are not obvious over Recktenwald in view of Smithies.

Recktenwald describes an item pick up system 100 that permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item when the item is not available on the sales floor or when the person must, or wishes to, pick up the item at a later time. See Recktenwald, col. 4, ll. 47-53 and Figure 1. The customer, or the customer's representative, may use a barcode scanner 200 of a kiosk 104 to scan a one-dimensional barcode from a sales check that was presented to the customer by a point-of-sale register attendant at the time that the customer purchased the item. See Recktenwald, col. 6, ll. 58-63 and Figure 5. The item pick up system 100 then searches one or more databases to find the items associated with the scanned one-dimensional barcode from the sales check.

Recktenwald does not, however, describe or suggest the use of a two-dimensional barcode, as set forth in independent claims 1 and 13 of the present invention. In the Final Office Action, the Examiner alleges that Recktenwald teaches a two-dimensional bar code because the bar code described by Recktenwald may be printed on paper, which is a two-dimensional object. Appellant respectfully disagrees and notes that the term "two-dimensional bar code" has been clearly defined in the specification in accordance with known usage in the art. In particular, a two-dimensional bar code can function as a database, in contrast to traditional one-dimensional bar codes like the one-dimensional bar code described in Recktenwald, which act as a pointer to reference information stored in a database.

Moreover, as admitted by the Examiner, Recktenwald does not describe or suggest scanning and decoding a barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's

current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention.

To remedy at least the acknowledged deficiencies of the primary reference, the Examiner cites Smithies. Smithies is directed to a computer-based method and system for capturing and verifying an electronically captured handwritten signature by comparing the electronically captured signature to an encrypted signature envelope. However, Smithies fails to teach or suggest use of a two-dimensional bar code. Thus, Recktenwald and Smithies fail to teach or suggest all the limitations set forth in claims 1, 13, and all claims depending therefrom.

Appellant also respectfully submits that the neither Recktenwald nor Smithies provides any suggestion or motivation to combine the teachings of the two references. To the contrary, Recktenwald appears to teach away from the Examiner's proposed modifications. In particular, the item pick up system described by Recktenwald permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item. Thus, Applicant respectfully submits that Recktenwald appears to teach away from any method of identifying the person holding the sales check. In particular, Recktenwald appears to teach away from verifying that the person holding the sales check including the scanned one-dimensional barcode is the person who purchased the item.

For at least this reason, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 1-2, 10-11, 13-14, and 22 are obvious over Recktenwald in view of Smithies. Appellants respectfully request that the Examiner's rejection of claims 1-2, 10-11, 13-14, and 22 be REVERSED.

C. Claims 3 and 15 are not obvious over Recktenwald and Smithies and further in view of Stephens.

Claims 3 and 15 depend from independent claims 1 and 13, respectively. Claims 3 and 15 set forth, in addition to the limitations set forth in the independent claims, notifying a user electronically occurs via a cell phone. Stephens describes notifying a customer via a cell phone when an item is ready for pickup. However, Stephens fails to remedy the aforementioned fundamental deficiencies in Recktenwald and Smithies with regard to independent claims 1 and 13.

For at least this reason, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 3 and 15 are obvious over Recktenwald in view of Smithies and further in view of Stephens. Appellants respectfully request that the Examiner's rejection of claims 3 and 15 be REVERSED.

D. Claims 12 and 23 are not obvious over Recktenwald and Smithies and further in view of Keagy.

Claims 12 and 23 depend from independent claims 1 and 13, respectively. Claims 12 and 23 set forth, in addition to the limitations set forth in the independent claims, a two-dimensional bar code that utilizes the PDF417 symbology. Keagy describes a two-dimensional bar code formed according to the PDF417 symbology. However, the prior art of record provides no suggestion or motivation to combine the teaching of Keagy with Recktenwald and Smithies. To the contrary, Recktenwald teaches away from using a two-dimensional bar code. In particular, Recktenwald teaches scanning a one-dimensional barcode and using the scanned one-

dimensional barcode as a pointer to one or more databases to find the items associated with the scanned one-dimensional barcode. See Recktenwald, col. 6, ll. 58-63 and Figure 5.

Keagy also fails to remedy other deficiencies with Recktenwald and Smithies. In particular, Keagy does not address Recktenwald's teaching away from verifying that the person holding the sales check including the scanned one-dimensional barcode is the person who purchased the item, as discussed above.

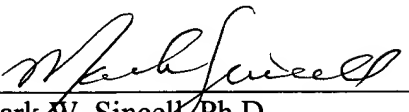
For at least this reason, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 12 and 23 are obvious over Recktenwald in view of Smithies and further in view of Keagy. Appellants respectfully request that the Examiner's rejection of claims 12 and 23 be REVERSED.

IX. CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application, claims 1-3, 10-15, and 22-23, over the prior art of record. The undersigned may be contacted at (713) 934-4052 with respect to any questions, comments or suggestions relating to this appeal.

Respectfully submitted,

Date: 3/3/05



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AGENT FOR APPLICANTS

APPENDIX A

1. (PREVIOUSLY PRESENTED) A method of obtaining a package, comprising:
notifying a user electronically that a package has arrived at a predetermined location;
printing a paper receipt including a two-dimensional bar code encoding a user's
previously provided biometric information;

at the predetermined location, scanning the two-dimensional bar code, decoding the
two-dimensional bar code to obtain the user's previously provided biometric information and
conveying a user's current biometric information to a retrieval device; and

if the user's current biometric information is equivalent to the user's previously
provided biometric information, providing the package to the user by the retrieval device.

2. (ORIGINAL) The method of claim 1, further comprising:
presenting the package for visual inspection by the user prior to providing the package
to the user by the retrieval device.

3. (ORIGINAL) The method of claim 2, wherein the step of notifying a user
electronically occurs via a cell phone.

4. (WITHDRAWN) The method of claim 2, wherein the step of notifying a user
electronically occurs via a PDA.

5. (WITHDRAWN) The method of claim 2, wherein the step of notifying a user electronically occurs via a two-way pager.

6. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's fingerprint.

7. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's 10 handprint.

8. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

9. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

10. (ORIGINAL) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

11. (ORIGINAL) The method of claim 10, wherein conveying the user's current biometric information is accomplished by:

affixing the user's signature to a signature bar code; and
scanning the signature bar code.

12. (ORIGINAL) The method of claim 2, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

13. (PREVIOUSLY PRESENTED) An apparatus for delivering goods, comprising:
a notifier for notifying a user electronically that a package has arrived at a predetermined location;

a scanner for scanning a two-dimensional bar code provided by a user at the predetermined location;

a decoder for decoding a user's previously provided biometric information from the two-dimensional bar code;

a collector for collecting a user's current biometric information;

a comparator for comparing the user's current biometric information and the user's previously provided biometric information; and

a provider for providing the package to the user if the user's current biometric information matches the user's previously provided biometric information.

14. (ORIGINAL) The apparatus of claim 13, further comprising:
a presenter for presenting the package for visual inspection by the user prior to
providing the package to the user by the provider.
15. (ORIGINAL) The apparatus of claim 14, wherein the notifier operates via a
cell phone.
16. (WITHDRAWN) The apparatus of claim 14, wherein the notifier operates via a
PDA.
17. (WITHDRAWN) The apparatus of claim 14, wherein the notifier operates via a
two-way pager.
18. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously
provided biometric information and the user's current biometric information include data
related to the user's fingerprint.
19. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously
provided biometric information and the user's current biometric information include data
related to the user's handprint.

20. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

21. (WITHDRAWN) The apparatus of claim 13, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

22. (ORIGINAL) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

23. (ORIGINAL) The apparatus of claim 14, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

24. (WITHDRAWN) A method of establishing a service for package delivery, comprising:

a user providing to a service provider select biometric information, select contact information, and select financial information in a secure fashion;

insuring that the select financial information and the select biometric information are stored in a secure manner apart from the select contact information; and

encoding the select biometric information so as to be capable of being printed in a two-dimensional bar code.

25. (WITHDRAWN) The method as in claim 24, further comprising:
the user ordering a package from a package provider and directing the provider to send the package to the service provider;
the package provider contacting the service provider to obtain the user's select contact information;
the service provider notifying the user electronically that the package has arrived at a predetermined location.

26. (WITHDRAWN) The method of claim 25, wherein the step of the user ordering a package is accomplished via the Internet.

27. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's facial features.

28. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's voiceprint.

29. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's fingerprint.

30. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's signature.

31. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's handprint.

32. (WITHDRAWN) A method of returning a package, comprising
a user notifying a package provider that the user desires to return a package to the package provider via a service provider;
after consultation with the package provider, the service provider notifying the user electronically that the package is ready to be accepted for return;
printing a paper return label including a two-dimensional bar code encoding the user's previously provided biometric information;
affixing the paper return label to the package;
at the predetermined location, scanning the two-dimensional bar code, decoding the two-dimensional bar code to obtain the user's previously provided biometric information and conveying the user's current biometric information to a deposit device;
if the user's current biometric information is equivalent to the user's current biometric information, the user providing the package to the service provider by the deposit device; and
the service provider providing the package to the package provider.

33. (WITHDRAWN) The method as in claim 32, further comprising:
querying the user the reason for returning the package.

34. (WITHDRAWN) The method as in claim 33, further comprising:
ascertaining the current physical dimension and weight parameters of the package by the deposit device and comparing the current physical dimension and weight parameters of the package with previously established physical dimension and weight 15 parameters provided by the package provider; and

if the current physical dimension and weight parameters are substantially equivalent to the previously established physical dimension and weight parameters, accepting the package by the service provider and crediting the user's financial account by the package provider for the amount spent on the package.

35. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric

information and the user's current biometric information include data related to the user's fingerprint.

36. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's handprint.

37. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

38. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

39. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

40. (WITHDRAWN) The method of claim 34, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

41. (WITHDRAWN) The method of claim 34, wherein the step of the user notifying the package, provider is accomplished via the Internet.